

REMARKS

Upon entry of this Amendment, claims 1-5 and 7-24 will remain pending, with claims 1-4 and 17-24 withdrawn from consideration. By this Amendment, Applicants amend claims 5 and 14. Support for this Amendment may be found in, for example, original claims 5 and 6, as well as Figs. 4B, 7, and 11, and corresponding text at pages 14, 19, and 20 of the specification.

In the final Office Action mailed June 29, 2005 ("Office Action"),¹ the Examiner rejected claims 5, 6, 9-11, and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,629,136 to Naidoo ("Naidoo") in view of U.S. Patent No. 6,058,311 to Tsukagoshi ("Tsukagoshi"), and further in view of U.S. Patent No. 6,311,185 to Markowitz et al. ("Markowitz"); rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Naidoo in view of Tsukagoshi, and further in view of Markowitz and U.S. Patent No. 6,072,875 to Tsudik ("Tsudik"); and rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Naidoo in view of Tsukagoshi, and further in view of Markowitz and U.S. Patent No. 6,636,489 to Fingerhut ("Fingerhut").

Applicants respectfully traverse the Examiner's rejections for the following reasons.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action

I. **Regarding the rejection of claims 5, 9-11, and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Naidoo in view of Tsukagoshi, and further in view of Markowitz**

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 5, 9-11, and 14-16² because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Naidoo*, *Tsukagoshi*, nor *Markowitz*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Independent claim 5 recites a service providing system including, for example,

- a location information provider configured to provide a location information of a mobile terminal;
- a service provider configured to provide a service dependent on the location information of [[a]] the mobile terminal to the mobile terminal; and
- a communication control unit configured to control communication among the mobile terminal, the location information provider, and the service provider,
 - wherein said communication control unit sends a location information request including a user identifier sent by the mobile terminal to the location information provider, converts a user identifier of the mobile terminal to a temporary identifier, and sends a service request without the temporary identifier to the service provider.

² Applicants have canceled claim 6, rendering the rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo*, in view of *Tsukagoshi*, and further in view of *Markowitz* moot.

Emphasis added.

Naidoo does not teach or suggest at least “a communication control unit configured to control communication among the mobile terminal, the location information provider, and the service provider,” as recited by independent claim 5. The Examiner asserts that “it is implicit that there is a communication control unit to control communication between the mobile terminal and the service provider” (Office Action at pp. 2-3). Applicants respectfully disagree and request that the Examiner identify explicit teachings of the reference(s) which allegedly teach each and every element recited by the claims. Pursuant to M.P.E.P. § 2112:

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'

Emphasis added. *Naidoo does not necessarily require a “communication control unit configured to control communication among the mobile terminal, the location information provider, and the service provider,” as recited by independent claim 5.* Rather, *Naidoo* may utilize the alleged mobile terminal or service provider to control communication. Indeed, *Naidoo* teaches in col. 11, lines 39-44 that “communications device 400 may be configured to transmit a request for information to content provider 410. Communications device 400 is also configured to send geographic location information.” That is, *Naidoo* teaches that the communications device 400 (which the Examiner alleges to constitute the claimed “mobile terminal”) itself controls communication, not a communication control unit as recited by independent claim 5.

Tsukagoshi and *Markowitz* also fail to teach or suggest at least this element, and the Examiner does not rely on *Tsukagoshi* or *Markowitz* for such teachings. Claim 5, therefore, is distinguishable over *Naidoo*, *Tsukagoshi*, and *Markowitz* at least for this reason.

Further, the Examiner asserts that *Naidoo* teaches the claimed “location information provider” in col. 4, lines 31-48 (Office Action mailed June 29, 2005 at p. 5). Even assuming *Naidoo* teaches a “location information provider” (which Applicants do not concede), as discussed above *Naidoo* still fails to teach or suggest a “communication control unit” and thus necessarily fails to teach the claimed communication control unit, which “sends a location information request including a user identifier sent by the mobile terminal to the location information provider,” as recited in independent claim 5. *Tsukagoshi* and *Markowitz* also fail to teach or suggest at least this element, and the Examiner does not rely on *Tsukagoshi* or *Markowitz* for these teachings either. Accordingly, claim 5 is distinguishable over the applied references for at least this additional reason.

Moreover, neither *Naidoo*, *Tsukagoshi*, or *Markowitz*, taken alone or in combination, teaches or suggests at least a communication control unit that “converts a user identifier of the mobile terminal to a temporary identifier; and sends a service request without the temporary identifier to the service provider,” as recited in independent claim 5. The Examiner concedes that both *Naidoo* and *Tsukagoshi* fail to teach or suggest at least a “temporary identifier,” and sending a “service request without the temporary identifier to the service provider” (Office Action at p. 3, 4).

The Examiner, nevertheless, asserts that *Markowitz* "teaches a system where there are multiple profiles of a user which stores different information and certain user profile[s] can be sent to a server provider" (Office Action at p. 4). Further, in the Advisory Action, the Examiner asserts that:

Markowitz teaches ... [a] user's profile is created based on a questionnaire submitted when the user registered ... one can interpret 'send the service request information to said service provider (a user requesting a webpage) ... without the temporary identifier (the request for the webpage has no temporary identifier because when a user request [sic] a webpage using the browser, for example, www.msn.com., there are [sic] no temporary identifier in this request)'

(Advisory Action at p. 2).

There is no teaching or suggestion in *Markowitz* to support the Examiner's assertion that a "request for a webpage has no temporary identifier" (Advisory Action at p. 2). Rather, *Markowitz* teaches in col. 3, lines 2-5 that "[a] history database 210 can be consulted ... [f]or example, if a user had previous requested a large number of Web pages related to sports, an advertisement for a sporting goods store might be selected." *Markowitz* therefore teaches identifying and tracking user requests to identify advertisements. As such, contrary to the Examiner's assertion, *Markowitz* does send an identifier with the request for a webpage. Accordingly, *Markowitz* does not teach or suggest at least sending a "service request without the temporary identifier to the service provider," as recited in independent claim 5.

In addition, there is no motivation found in the references to modify the teachings of *Naidoo*, with those of *Tsukagoshi*, and further with those of *Markowitz*. Pursuant to M.P.E.P. § 2141:

The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination

(Emphasis added). By transmitting the service request without the temporary identifier as recited in claim 5, users may remain anonymous to the service provider. *Naidoo*, *Tsukagoshi*, and *Markowitz* all teach away from anonymity and sending a “service request without the temporary identifier to the service provider,” as recited by claim 5. *Naidoo* teaches requiring a “login name and password” in col. 8, line 58, *Tsukagoshi* teaches in Fig. 3 that the data request is sent using the temporary identifier, and *Markowitz* teaches identifying users to track webpage requests in col. 3, lines 2-5.

Therefore, one of ordinary skill in the art would not look to modify the teachings of *Naidoo*, *Tsukagoshi*, and *Markowitz* to send a “service request without the temporary identifier to the service provider,” as recited in independent claim 5.

Because neither *Naidoo*, *Tsukagoshi*, nor *Markowitz*, taken alone or in combination, teaches or suggests each and every element recited in independent claim 5 and required by dependent claims 9-11, and further because there is no motivation to combine the applied references, no *prima facie* case of obviousness has been established with respect to these claims. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 5 and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz*.

Independent claim 14, although of different scope, recites elements similar to those discussed above with respect to claim 5. Claims 15 and 16 depend from claim 14 and therefore include all of the elements recited therein. Accordingly, for at least the

reasons discussed above with respect to claim 5, no *prima facie* case of obviousness has been established for claims 14-16. Applicants therefore respectfully request the Examiner to reconsider and withdraw the rejection of claims 14-16 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz*.

II. Regarding the rejection of claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz* and *Tsudik*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 7 and 8 because a *prima facie* case of obviousness has not been established with respect to these claims. A *prima facie* case of obviousness has not been established because, among other things, neither *Naidoo*, *Tsukagoshi*, *Markowitz*, nor *Tsudik*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

As noted above, independent claim 5 recites a combination including, for example,

wherein said communication control unit sends a location information request including a user identifier sent by the mobile terminal to the location information provider, converts a user identifier of the mobile terminal to a temporary identifier, and sends a service request without the temporary identifier to the service provider

(Emphasis added). Also as noted above, neither *Naidoo*, *Tsukagoshi*, or *Markowitz*, taken alone or in combination, teaches or suggests at least these elements recited by independent claim 5 and required by dependent claims 7 and 8.

The Examiner asserts "Tsudik teaches two different identifier[s] being corresponded to each other(Abstract)" (Office Action at p. 7). Even assuming this

assertion to be true, *Tsudik* fails to cure the deficiencies of *Naidoo*, *Tsukagoshi*, and *Markowitz* discussed above.

Claims 7 and 8 are therefore allowable over the applied references at least due to their dependence from claim 5.

III. Regarding the rejection of claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over *Naidoo* in view of *Tsukagoshi*, and further in view of *Markowitz* and *Fingerhut*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 12 and 13 because a *prima facie* case of obviousness has not been established with respect to these claims. A *prima facie* case of obviousness has not been established because, among other things, neither *Naidoo*, *Tsukagoshi*, *Markowitz*, nor *Fingerhut*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

The Examiner contends that "Fingerhut teaches a location independent service provider" (Office Action at p. 8). Even if such teachings are present in *Fingerhut* and are combinable with *Naidoo*, *Tsukagoshi*, and *Markowitz* in the manner proposed by the Examiner, *Fingerhut* would still fail to teach the claimed

communication control unit sends a location information request including a user identifier sent by the mobile terminal to the location information provider, converts a user identifier of the mobile terminal to a temporary identifier, and sends a service request without the temporary identifier to the service provider.

Emphasis added. Thus, *Fingerhut* also fails to cure the deficiencies of *Naidoo*, *Tsukagoshi*, and *Markowitz* discussed above, and claims 12 and 13 are allowable at least due to their dependence from claim 5.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

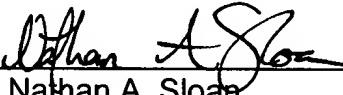
Should the Examiner continue to dispute the patentability of the claims after consideration of this Reply, Applicants encourage the Examiner to contact Applicants' undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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